



# INTELLECTUAL PROPERTY LAW

## Volume One

### Patents & Trade Secrets

Spring 1997

Professor Norman Siebrasse

These materials are solely for the classroom use of students at the Faculty of Law,  
University of Toronto.

2078  
251  
1997  
✓  
61

AYG 09-2

BORA LASKIN LAW LIBRARY  
DEC 9 1996  
FACULTY OF LAW  
UNIVERSITY OF TORONTO

# **INTELLECTUAL PROPERTY LAW**


## **Volume One**

### **Patents & Trade Secrets**

Spring 1997

Professor Norman Siebrasse

These materials are solely for the classroom use of students at the Faculty of Law,  
University of Toronto.



Digitized by the Internet Archive  
in 2018 with funding from  
University of Toronto

<https://archive.org/details/intellectualprop01sieb>

# Intellectual Property Law

Spring 1997

Professor Norman Siebrasse

## Volume I – Patents & Trade Secrets

### Patents

#### I. Introduction

##### CHAPTER 1. GENERAL

John W. Ross, Beyond the Better Mousetrap: An Introduction to Patents . . . . .	1-1
William M. Landes & Richard Posner, "An Economic Analysis of Copyright Law" (1989) 18 J. Legal Stud. 325 . . . . .	1-31
Canadian Patent No. 883,719 . . . . .	1-35

#### II. Validity of the Patent

##### CHAPTER 2. PRESUMPTION OF VALIDITY

Tye-Sil Corp. v Diversified Products Corp . . . . .	2-1
Greg Aharonian, Is the US patent system a registration system? . . . . .	2-3

##### *An Invention*

##### CHAPTER 3. UTILITY

X v Commr. of Patents . . . . .	3-1
Brenner, Commissioner of Patents v. Manson . . . . .	3-3
Hammond, "Inutility Attacks on Canadian Patents" . . . . .	3-8

##### CHAPTER 4. NOVELTY/ANTICIPATION

###### A What must be anticipated?

Xerox of Canada Ltd. v IBM Canada Ltd. . . . .	4-1
Reeves Brothers Inc. v. Toronto Quilting & Embroidery Ltd. . . . .	4-5
Diversified Products Corp. v. Tye-Sil Corp. . . . .	4-5

###### B What is "public"?

###### Special Relationship

Saunders Et Al. v. Airglide Deflectors Ltd. Et al. . . . .	4-7
--	-----

###### Prior publication

Beloit Canada Ltee/Ltd. v. Valmet OY . . . . .	4-8
Beloit Corp. v. J.M. Voith GmbH . . . . .	4-10

###### Public use

Windsurfing International Inc v Tabur Marine (Great Britain) Ltd . . . . .	4-11
Windsurfing International Inc. v. Trilantic Corporation . . . . .	4-15
U.S. Patent # 5,401,504 . . . . .	4-18
M. Uniyal, Biopirates Stake Claim to Southern Knowledge . . . . .	4-20

## CHAPTER 5. NON-OBVIOUSNESS

C	What must be non-obvious? Discovery, product and process.	
	Continental Soya Co. v. J.R. Short Milling Co. ....	5-1
	Hoffmann-LaRoche & Co. v. Canada (Commissioner of Patents) ....	5-3
	Canada (Commissioner of Patents) v. Ciba Ltd. ....	5-5
	Shell Oil Co. v. Canada (Commissioner of Patents) ....	5-7
	Scripps Clinic & Research Foundation v. Genentech, Inc. ....	5-10
	Farbwerke Hoechst AG v. Halocarbon (Ontario) Ltd. ....	5-12
	Beloit Canada Ltee/Ltd. v. Valmet Oy ....	5-22
	Graham et al. V. John Deere Co. ....	5-28
D	Commercial Success	
	Rothmans, Benson & Hedges Inc. v. Imperial Tobacco Ltd. ....	5-32
E	Obviousness and Anticipation	
	Rothmans, Benson & Hedges Inc. v. Imperial Tobacco Ltd. ....	5-33
F	Obviousness and Recombinant DNA technology	
	M. L. Gravelle, Biotechnology – An Overview ....	5-34
	Genentech Inc's Patent ....	5-40
	Biogen Inc v Medeva PLC ....	5-44
	In re Merck & Co., Inc. ....	5-45
	Amgen, Inc., v. Chugai Pharmaceutical Co., Ltd, ....	5-48

## CHAPTER 6. PATENTABLE SUBJECT MATTER

G	General	
	Canadian Patent Office, Manual of Patent Office Practice ....	6-1
	Definitions of “Invention” ....	6-3
	Harold G. Fox, Canadian Patent Law and Practice, 4th ed. ....	6-5
	Excerpt from fox p.22-5, UK-Act.def, Statue of Monopolies	
	GEC’s Application ....	6-8
H	Computer Implemented Inventions	
	Schlumberger Canada Ltd. v. Commissioner of Patents ....	6-10
	Re Application for Patent of Tokyo Shibaura Electric Co. Ltd. ....	6-12
	Re Application for Patent of Mobil Oil Corp ....	6-14
	Re Application for Patent of Dissly Research Corp. ....	6-16
	Patent Branch Guidelines ....	6-19
	Gottschalk, Acting Commissioner of Patents V. Benson ....	6-20
	Parker, Acting Commissioner of Patents v. Flook ....	6-22
	In Re Alappat ....	6-27
I	Living subject matter	
	Diamond, Commissioner of Patents v. Chakrabarty ....	6-36
	Re Application of Abitibi Co. ....	6-43
	Pioneer Hi-bred Ltd. v. Commissioner of Patents ....	6-52
	Decision Re Application No. 484, 723 (the “Harvard mouse”) ....	6-57



J	Methods of Doing Business	
	Lawson v Commr. of Patents . . . . .	6-66
	Paine, Webber, Jackson & Curtis, Inc., v. Merrill Lynch, Pierce, Fenner & Smith, Inc. . . . .	6-74
	Re Application for Patent No. 178,570 (Securities Valuation System) . . . . .	6-80

## *Properly Claimed*

### CHAPTER 7. CONSTRUCTION OF THE PATENT

A	General	
	Consolboard Inc. v. MacMillan Bloedel (Saskatchewan) Ltd. . . . .	7-1
	Burton Parsons Chemicals, Inc. v. Hewlett-Packard (Canada) Ltd. . . . .	7-8
B	Relationship between disclosure and claims	
	Beecham Canada Ltd. v. Procter & Gamble Co. . . . .	7-15
	Dableh v. Ontario Hydro . . . . .	7-19
	TRW Inc. v. Walbar of Canada Inc. . . . .	7-21
C	Relationship between Construal and Validity	
	Nekoosa Packaging Corp. v. AMCA International Ltd. . . . .	7-25
D	Expert & Parole Evidence	
	C.G.E. v. Fada Radio . . . . .	7-26
	Nekoosa Packaging Corp. v. AMCA International Ltd. . . . .	7-26
	Mobil Oil Corp. et al. v. Hercules Canada Inc. . . . .	7-28
E	Construal Date	
	AT & T Technologies, Inc. v. Mitel Corp. . . . .	7-30
	AlliedSignal Inc. v Du Pont Canada Inc. . . . .	7-33

### CHAPTER 7. DEFECTS IN CLAIMS

F	Ambiguous Claims	
	Natural Colour Kinematograph Co. Ltd. v. Bioschemes Ltd. . . . .	7-34
	Henriksen v. Tallon Limited . . . . .	7-34
	Noranda Mines Ltd. v. Minerals Separation Corp. (Ex.Ct.) . . . . .	7-35
	Noranda Mines Ltd. v. Minerals Separation Corp. (S.C.C.) . . . . .	7-36
	Minerals Separation Corp. v. Noranda Mines Ltd. (J.C.P.C.) . . . . .	7-38
G	Claim the invention	
	Electric and Musical Industries v.Lissen . . . . .	7-40
H	Covetous Claims	
	Leithiser v Pengo Hydra-Pull of Canada Ltd. . . . .	7-41
I	Inadequate disclosure ok 1.5	
	TRW Inc. v. Walbar of Canada Inc. . . . .	7-45
J	Best mode	
	Lido Industrial Products Ltd. v. Teledyne Industries Inc. . . . .	7-46

### **III. Infringement**

#### **CHAPTER 8. DETERMINING INFRINGEMENT**

McPhar Eng. v Sharpe Instruments . . . . .	8-1
Catnic Components Ltd v Hill and Smith Ltd . . . . .	8-8
Improver Corp. v Remington Consumer Products Ltd. . . . .	8-14
Eli Lilly & Co. v O'Hara Mrg. Ltd. . . . .	8-20
Imperial Oil Ltd v Lubrizoil Corp . . . . .	8-26
Mobil Oil Corp. v. Hercules Canada Inc. . . . .	8-30

### **IV. Remedies**

#### **CHAPTER 9**

A Interlocutory Injunction	
Cutter Ltd. v. Baxter Travenol Laboratories of Canada, Ltd. . . . .	9-1
B Permanent Injunction	
Cochlear Corp. v. Cosem Neurostim Ltee . . . . .	9-5
C Delivery up	
Cutter Ltd. v. Baxter Travenol Laboratories of Canada, Ltd . . . . .	9-7
D Damages	
Consolboard Inc. v. Macmillan Bloedel (Saskatchewan) Ltd. . . . .	9-11
Unilever PLC v. Procter & Gamble Inc. . . . .	9-15
E Accounting of Profits	
Baker Energy Resources Corp. v. Reading & Bates Construction Co. . . . .	9-19

### **V. The Patent Cooperation Treaty**

#### **CHAPTER 10**

Canadian Patent Office, Manual of Patent Office Practice . . . . .	10-1
--	------



# Trade Secrets

## VI. Trade Secrets

### CHAPTER 11 BASIS FOR THE ACTION

#### A General Principles

Coco v. A. N. Clark (Engineers) Ltd. . . . . 11-1

#### B Confidential Information

International Tools Ltd. v. Kollar et al. . . . . 11-4

#### C Communicated . . .

Saltman Engineering Co. v. Campbell Engineering Co. . . . . 11-8

#### D . . . in Circumstances Imparting an Obligation of Confidence

Coco v. A. N. Clark (Engineers) Ltd. . . . . 11-8

#### Obligations of an Employee

Delrina Corp. v. Triolet Systems Inc. . . . . 11-10

### CHAPTER 12 REMEDIES

#### E Damages

Seager v. Copydex, Ltd. (No. 2). . . . . 12-1

ICAM Technologies Corp. v. EBCO Industries Ltd. . . . . 12-2

#### Springboard

Coco v. A. N. Clark (Engineers) Ltd . . . . . 12-8

Cadbury Schweppes Inc. v. FBI Foods Ltd. . . . . 12-11

#### F Injunctions

#### Injunctions and Third Parties

International Tools Ltd. v. Kollar et al. . . . . 12-14

#### Springboard

Cadbury Schweppes Inc. v. FBI Foods Ltd. . . . . 12-16

#### G Constructive Trust

LAC Minerals Ltd. v. International Corona Resources Ltd. . . . . 12-18

